

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: S.K. Sharma et al.

APPLICATION NO.: 10/717,244 : Examiner: none

FILING DATE: November 19, 2003 : Group Art Unit: none

TITLE: Soluble Notched-Based Substrates for
Gamma Secretase and Methods and
Compositions for Using Same

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Renewed Petition under 37 CFR 1.137(b)

Preliminary Considerations

Applicant hereby petitions for further consideration of its "Petition to Revive Unintentionally Abandoned Application", mailed December 7, 2005. Applicant's Petition was dismissed, as being incomplete, by way of the Decision mailed June 12, 2006. Applicant's present submission provides necessary further explanatory information and completes the needed response (which is confined to identified defects in the Sequence Listing).

The Petitions Attorney should first note that correction of the defects in the Sequence Listing (the SEQ ID NO identifiers ran consecutively except that a few numbers ..1..2..3..4..5... were accidentally skipped) has required preparation of a substitute specification, and retrieving the original as-filed specification from archive has taken additional time. Thus, as is permitted, a Petition for Extension of Time (two months) is also provided in duplicate.

Although it is believed that no fees (other than for the extension of time) are now due, the Patent Office is authorized to charge any needed fee, or fee amount, or credit any overpayment to Deposit Account 16-1445, and the present document should also be considered as a Petition in regard of any such fee.

Remarks

In the Decision dismissing Applicant's Petition, it was noted that the Applicant had neither addressed (nor responded to) the Notice to File Missing Parts, originally mailed July 6, 2004, and which pertains only to defects the Sequence Listing. However, until a copy of this Notice was provided with a Copy of the Decision on the Petition, Applicant did not have a copy of this document, and any failure to take into account this further Notice was also unintentional (see below).

As an exhibit to the original Petition herein, mailed December 7, 2005, Applicant attached a company docket report for the present matter showing no due dates whatever for this case. Docket dates are never cancelled, unless the outstanding item has been responded to. As was also clearly explained in the December 7, 2005 Petition, the merger of Pharmacia and Upjohn into Pfizer did result in some computer docketing errors, especially in cases such as this, where responsibility for a case was being transferred from a former Pharmacia site to a legacy-Pfizer site, in this case from the Kalamazoo Michigan Patent Department to the New York City Department.

The Petitions Examiner is therefore first requested to review Applicant's December 7, 2005 Petition in order to correctly frame the context of the present renewed Petition.

It is impossible to determine if the July 6, 2004 Patent Office Notice was lost in the US Mail, and therefore not delivered, or if it was delivered to a clerk in the Kalamazoo, Michigan Patent Department facility, and not properly handled. All that can be determined is that, for whatever reason, the paper was never docketed, as evidenced by the computer printout previously provided. Therefore, it is believed that these circumstances fully qualify as unintentional, during the period of relevant time.

In regard of the other circumstances and time periods presently involved, it is believed that the prior Petition is explanatory. The undersigned attorney ran a routine docket check on December 6, 2005 merely to investigate why no Patent Office action had occurred in regard of a few unrelated cases. In regard of the present case, it was determined that the Notice of Abandonment was apparently received but never docketed, again by circumstances somehow resulting from the merger of Pharmacia and Upjohn into Pfizer, and the transfer of prosecution responsibilities between corporate sites.

Finally, in regard of Applicant's Petition herein of December 7, 2005, the undersigned attorney stated therein that the Patent Office may have lost Applicant's original response to the Notice to File Missing Parts mailed March 22, 2004, which response was provided on May 24, 2004. As discussed in the Petition, the attorney responsible at the time had noted in his response to that Notice that the actual sheets describing what was supposedly wrong with the Sequence Listing were not attached to that Notice. The undersigned attorney believed that failure of the Patent Office to in-take the May 24, 2004 Response resulted in abandonment. *In fact*, the Patent Office did

respond to the original attorney's request for the missing Raw Sequence Listing Error Report sheets, by way of a subsequent Notice to File Missing Parts, mailed July 6, 2004. Applicant's failure to respond to this subsequent document, in fact, has triggered the current abandonment. However, as aforementioned, the July 6, 2004 Notice was not docketed (see the docket report exhibit previously provided), responsibility for the case was transferred from one corporate facility to another, and the originally responsible attorney left the company.

Therefore, to complete the accounting of unintentional delay as to all periods of time that have elapsed, and although the undersigned attorney immediately petitioned for revival of the case on December 7, 2005 having discovered its status on December 6, 2005, it should be noted that the undersigned attorney has contributed to confusion herein. The undersigned attorney believed that the defects in Applicant's papers stemmed from an incomplete or lost response to the March 22, 2004 Notice to File Missing Parts, when in fact, the undersigned attorney failed to note that a second Notice to File Missing Parts, dated July 6, 2004, had mailed and was actually at issue, which document was either not received or not docketed within the Company. It is also believed that the present application file had not yet been scanned into Private Pair during the 2004 time periods originally relevant herein.

Taking into account the present Renewed Petition, and the original Petition, it is believed that a concise and adequate showing has been presented that all of the delays affecting this case, albeit regrettable, are unintentional, and are based on clerical errors owing to the merger of two companies. Therefore, it is believed that proper grounds exist for revival of the application, which is respectfully requested. It should be noted that the only substantive error that actually exists in the application merely involves a consecutive numbering defect in the SEQ ID NO identifiers, which defect is now fully and properly corrected.

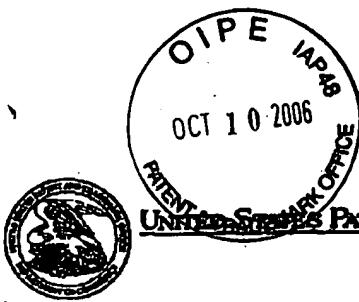
Respectfully submitted,



Dr. E. Victor Donahue,
Senior Patent Counsel,
Attorney for Applicant(s)
Reg. No. 35,492

Date: October 9, 2006

Pfizer, Inc.
Legal Department, 5th Floor
150 East 42nd Street
New York, NY 10017-5755
(212) 733-2739



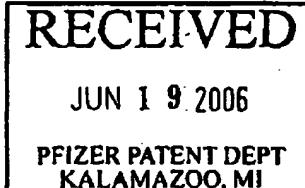
COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
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www.uspto.gov

APPLICATION NUMBER	FLING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/717,244	11/19/2003	Satish Kumar Sharma	01130.US1

25533
PHARMACIA & UPJOHN
301 HENRIETTA ST
0228-32-LAW
KALAMAZOO, MI 49007



CONFIRMATION NO. 8886

FORMALITIES LETTER

0000000013154850

Date Mailed: 07/08/2004

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE
DISCLOSURES**

Filing Date Granted

Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file the items indicated below to avoid abandonment. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

- A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing." Applicant must provide a substitute computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d).

For questions regarding compliance to these requirements, please contact:

- For Rules Interpretation, call (703) 308-4216
- To Purchase Patentin Software, call (703) 306-2600
- For Patentin Software Program Help, call (703) 308-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov

Replies should be mailed to: Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

*A copy of this notice **MUST** be returned with the reply.*

COPY

P. Linder
Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 3 - OFFICE COPY



BIOTECHNOLOGY
SYSTEMS
BRANCH

RAW SEQUENCE LISTING ERROR REPORT

The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) detected errors when processing the following computer readable form:

Application Serial Number: 10/717 244

Source: TTDO

Date Processed by STIC: 10/19/03

THE ATTACHED PRINTOUT EXPLAINS DETECTED ERRORS.

PLEASE FORWARD THIS INFORMATION TO THE APPLICANT BY EITHER:

- 1) INCLUDING A COPY OF THIS PRINTOUT IN YOUR NEXT COMMUNICATION TO THE APPLICANT, WITH A NOTICE TO COMPLY or,
- 2) TELEPHONING APPLICANT AND FAXING A COPY OF THIS PRINTOUT, WITH A NOTICE TO COMPLY

FOR CRF SUBMISSION AND PATENTIN SOFTWARE QUESTIONS, PLEASE CONTACT MARK SPENCER, TELEPHONE: 703-308-4212; FAX: 703-308-4221

Effective 12/13/03: TELEPHONE: 571-272-2510; FAX: 571-273-0221

TO REDUCE ERRORED SEQUENCE LISTINGS, PLEASE USE THE CHECKER VERSION 4.1 PROGRAM, ACCESSIBLE THROUGH THE U.S. PATENT AND TRADEMARK OFFICE WEBSITE. SEE BELOW FOR ADDRESS:

<http://www.uspto.gov/web/offices/pac/checker/chkr41note.htm>

Applicants submitting genetic sequence information electronically on diskette or CD-Rom should be aware that there is a possibility that the disk/CD-Rom may have been affected by treatment given to all incoming mail.

Please consider using alternate methods of submission for the disk/CD-Rom or replacement disk/CD-Rom.

Any reply including a sequence listing in electronic form should NOT be sent to the 20231 zip code address for the United States Patent and Trademark Office, and instead should be sent via the following to the indicated addresses:

1. EFS-Bio (<http://www.uspto.gov/cbc/efs/downloads/documents.htm>), EFS Submission User Manual - ePAVE
2. U.S. Postal Service: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
3. Hand Carry directly to (EFFECTIVE 12/01/03):
U.S. Patent and Trademark Office, Box Sequence, Customer Window, Lobby, Room 1B03, Crystal Plaza Two, 2011 South Clark Place, Arlington, VA 22202
4. Federal Express, United Parcel Service, or other delivery service to: U.S. Patent and Trademark Office, Box Sequence, Room 1B03-Mailroom, Crystal Plaza Two, 2011 South Clark Place, Arlington, VA 22202

Revised 10/08/03

Raw Sequence Listing Error Summary

ERROR DETECTED

SUGGESTED CORRECTION

SERIAL NUMBER: 10/7/7,244

ATTN: NEW RULES CASES: PLEASE DISREGARD ENCLII "ALPHA" HEADERS, WHICH WERE INSERTED BY ITO SOFTWARE

- 1 Wrapped Nucleic Acid
 Wrapped Aminos The number/text at the end of each line "wrapped" down to the next line. This may occur if your file was retrieved in a word processor after creating it. Please adjust your right margin to .3; this will prevent "wrapping."
- 2 Invalid Line Length The rules require that a line not exceed 72 characters in length. This includes white spaces.
- 3 Misaligned Amino Acid Numbering The numbering under each 5th amino acid is misaligned. Do not use tab codes between numbers; use space characters, instead.
- 4 Non-ASCII The submitted file was not saved in ASCII(DOS) text, as required by the Sequence Rules. Please ensure your subsequent submission is saved in ASCII text.
- 5 Variable Length Sequence(s) 79 contain n's or Xaa's representing more than one residue. Per Sequence Rules, each n or Xaa can only represent a single residue. Please present the maximum number of each residue having variable length and indicate in the <220>~<223> section that some may be missing.
- 6 PatentIn 2.0 "bug" A "bug" in PatentIn version 2.0 has caused the <220>~<223> section to be missing from amino acid sequences(s) 79. Normally, PatentIn would automatically generate this section from the previously coded nucleic acid sequence. Please manually copy the relevant <220>~<223> section to the subsequent amino acid sequence. This applies to the mandatory <220>~<223> sections for Artificial or Unknown sequences.
- 7 Skipped Sequences (OLD RULES) Sequence(s) 79 missing. If intentional, please insert the following lines for each skipped sequence:
(2) INFORMATION FOR SEQ ID NO:X: (insert SEQ ID NO where "X" is shown)
(i). SEQUENCE CHARACTERISTICS: (Do not insert any subheadings under this heading)
(ii) SEQUENCE DESCRIPTION:SEQ ID NO:X: (insert SEQ ID NO where "X" is shown)
This sequence is intentionally skipped

Please also adjust the "(ii) NUMBER OF SEQUENCES:" response to include the skipped sequences.
- 8 Skipped Sequences (NEW RULES) Sequence(s) 79 missing. If intentional, please insert the following lines for each skipped sequence.
<210> sequence id number
<400> sequence id number
000
- 9 Use of n's or Xaa's (NEW RULES) Use of n's and/or Xaa's have been detected in the Sequence Listing.
Per 1.823 of Sequence Rules, use of <220>~<223> is MANDATORY if n's or Xaa's are present.
In <220> to <223> section, please explain location of n or Xaa, and which residue n or Xaa represents.
- 10 Invalid <213> Response Per 1.823 of Sequence Rules, the only valid <213> responses are: Unknown, Artificial Sequence, or scientific name (Genus/species). <220>~<223> section is required when <213> response is Unknown or is Artificial Sequence
- 11 Use of <220> Sequence(s) 79 missing the <220> "Feature" and associated numeric identifiers and responses. Use of <220> to <223> is MANDATORY if <213> "Organism" response is "Artificial Sequence" or "Unknown." Please explain source of genetic material in <220> to <223> section.
(See "Federal Register," 02/01/1998, Vol. 63, No. 104, pp. 29631-32) (Sec. 1.823 of Sequence Rules)
- 12 PatentIn 2.0 "bug" Please do not use "Copy to Disk" function of PatentIn version 2.0. This causes a corrupted file, resulting in missing mandatory numeric identifiers and responses (as indicated on raw sequence listing). Instead, please use "File Manager" or any other manual means to copy file to floppy disk.
- 13 Misuse of n/Xaa "n" can only represent a single nucleotide; "Xaa" can only represent a single amino acid



JFWK

RAW SEQUENCE LISTING
PATENT APPLICATION: US/10/717,244

DATE: 12/04/2003
TIME: 11:18:33

Input Set : A:\01130final.txt
Output Set: N:\CRF4\12042003\J717244.raw

3 <110> APPLICANT: Sharma et al.
5 <120> TITLE OF INVENTION: SOLUBLE NOTCH-BASED SUBSTRATES FOR GAMMA SECRETASE AND
METHODS AND
6 COMPOSITIONS FOR USING SAME
8 <130> FILE REFERENCE: 28341/01130
C--> 10 <140> CURRENT APPLICATION NUMBER: US/10/717,244
C--> 10 <141> CURRENT FILING DATE: 2003-11-19
10 <160> NUMBER OF SEQ ID NOS: 17
12 <170> SOFTWARE: PatentIn version 3.1

ERRORED SEQUENCES

Does Not Comply
Corrected Diskette Needed

1702 <210> SEQ ID NO: 7
E--> 1703 <211> LENGTH:
E--> 1704 <212> TYPE:
W--> 1705 <213> ORGANISM:
1707 <220> FEATURE:
1708 <223> OTHER INFORMATION:
W--> 1709 <400> 7
1711 deleted
1714 <210> SEQ ID NO: 8
E--> 1715 <211> LENGTH:
E--> 1716 <212> TYPE:
W--> 1717 <213> ORGANISM:
1718 <220> FEATURE:
1719 <223> OTHER INFORMATION:
W--> 1720 <400> 8
1722 deleted
1724 <210> SEQ ID NO: 9
E--> 1725 <211> LENGTH:
E--> 1726 <212> TYPE:
W--> 1727 <213> ORGANISM:
1729 <220> FEATURE:
1730 <223> OTHER INFORMATION:
W--> 1731 <400> 9
1733 deleted

> If these are
intentionally skipped sequences, please
use the format on item 8 of the
error summary sheet.

> Same error

> Same error

VERIFICATION SUMMARY

PATENT APPLICATION: US/10/717,244

DATE: 12/04/2003

TIME: 11:18:34

Input Set : A:\01130final.txt
Output Set: N:\CRF4\12042003\J717244.raw

L:10 M:270 C: Current Application Number differs, Replaced Current Application No
L:10 M:271 C: Current Filing Date differs, Replaced Current Filing Date
L:1286 M:341 W: (46) "n" or "Xaa" used, for SEQ ID#:6 after pos.:880
M:341 Repeated in SeqNo=6
L:1703 M:210 E: (40) Invalid Number of Sequences, LENGTH:
L:1704 M:310 E: (3) Wrong or Missing Sequence Type, TYPE:
L:1705 M:201 W: Mandatory field data missing, <213> ORGANISM
L:1709 M:258 W: Mandatory Feature missing, <223> Blank for SEQ#:7,Line#:1708
L:1715 M:210 E: (40) Invalid Number of Sequences, LENGTH:
L:1716 M:310 E: (3) Wrong or Missing Sequence Type, TYPE:
L:1717 M:201 W: Mandatory field data missing, <213> ORGANISM
L:1720 M:258 W: Mandatory Feature missing, <223> Blank for SEQ#:8,Line#:1719
L:1725 M:210 E: (40) Invalid Number of Sequences, LENGTH:
L:1726 M:310 E: (3) Wrong or Missing Sequence Type, TYPE:
L:1727 M:201 W: Mandatory field data missing, <213> ORGANISM
L:1731 M:258 W: Mandatory Feature missing, <223> Blank for SEQ#:9,Line#:1730



UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

E. Victor Donahue
NY

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

RECEIVED

JUN 19 2006

PFIZER PATENT
KALAMAZOO, MI

Docketed

DATE 8-12-06

FOR Req for Reconsideration

BY: Marquette Site: KZOO

COPY MAILED

JUN 12 2006

OFFICE OF PETITIONS

OIPE 14P48
OCT 10 2006
PATENT & TRADEMARK OFFICE
PHARMACIA & UPJOHN
7000 PORTAGE ROAD
KZO-300-104
KALAMAZOO MI 49001

In re Application of
Sharma, et al.
Application No.: 10/717,244
Filing Date: 19 November, 2003
Attorney Docket No. 01130.US1

DECISION

This is a decision on the petition filed on 12 December, 2005, to revive the instant application under 37 C.F.R. §1.137(b) as having as abandoned due to unintentional delay.

For the reasons set forth below the petition as considered under 37 C.F.R. §1.137(b) is **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)."
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record reflects that:

COPY

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 6 July, 2004, with reply due absent extension of time on or before Tuesday, 7 September, 2004;
- the application went abandoned by operation of law after midnight 6 September, 2004;
- the Office mailed the Notice of Abandonment on 10 March, 2005;
- with the instant petition (with fee), Petitioner refers to merger matters and addresses a reply to a March 2004 Notice, but does not address the failure to reply to the 6 July, 2004, Notice, to which the March, 2005 Notice of Abandonment refers—for Petitioner's information, a copy of the 6 July, 2004, Notice is enclosed (it also is available to Petitioner on Private PAIR), and this is the matter to which Petitioner must reply to satisfy his burden under the Rule.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶)

Allegations as to
Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and--where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

As indicated in the BACKGROUND section, above, it appears as of this writing that Petitioner has yet to satisfy the "reply" requirement under the regulation.

CONCLUSION

The petition as considered under 37 C.F.R. §1.137(b) is dismissed.

Further correspondence with respect to this matter should be addressed as follows:⁷

By mail: Commissioner for Patents⁸
 P.O. Box 1450
 Alexandria, VA 22313-1450

⁴ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁷ On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. The number (571) 273-8300 is to be the only facsimile number recognized for centralized delivery. (For further information, see: <http://www.uspto.gov/web/offices/pac/dapp/opia/preognitice/cfax062005.pdf>.)

⁸ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

Encl